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MAILED

MAR 25 2009

OFFICE OF PETITIONS

In re Application of	:	
NOMURA et al.	:	
Application No. 10/765,048	:	LETTER REGARDING
Filed: January 28, 2004	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 04853.0111	:	

This is in response to the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR REVIEW OF CALCULATION" filed September 24, 2008. Pursuant to applicants' duty of good faith and candor to the Office, applicants request that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **532 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 1, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 567 days. On September 24, 2008, applicants submitted the instant comment. Applicants disclose that they believe that the determination of patent term adjustment of 567 days is incorrect and should be set at 561 days.

Applicants assert that they are entitled to an additional patent term adjustment of 11 days pursuant to 37 CFR 1.703(a)(2).¹ Applicants stated that the Office mailed a nonfinal Office action on January 29, 2007, which was subsequently withdrawn in favor of the corrected nonfinal Office action of March 27, 2007. Applicants contend that the Office should have used the March 27, 2007 mailing date of the corrected nonfinal Office action for the purpose of calculating any adjustment of patent term pursuant to 37 CFR 1.703(a)(2). Applicants assert they filed a Response to Restriction Requirement on November 16, 2006. However, the Office did not respond to the reply until the mailing of the corrected nonfinal Office action on March 27, 2007, four months and 11 days later. Thus, applicants contend that an additional period of adjustment of 11 days should be entered.

Applicants' argument has been considered. However, in light of the application history, it has been determined that the additional period of adjustment of 11 days for Office delay pursuant to 37 CFR 1.702(a)(2) is not merited. It is undisputed that the Office mailed a nonfinal Office action on January 29, 2007, within four months of the reply of November 16, 2006. On March 27, 2007, the Office mailed a corrected nonfinal Office action, which withdrew the nonfinal Office action of January 29, 2007, and restarted the period for reply.

The subsequent mailing of another Office action under 35 U.S.C. 132 does not alter the date used in calculation of the period of adjustment. Pursuant to 35 U.S.C. 154(b)(1)(A)(ii),² applicants

¹ 37 CFR 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

² 35 U.S.C. 154(b)(1)(A) provides that:

— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after the first four months of pendency of the application before the Office, to the extent that the Office failed to make an objection or argument under 35 U.S.C. 132 until January 29, 2007. The fact that the Office later withdrew the nonfinal Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2)³ on January 29, 2007. Thus, it is correct for the Office to use the date of January 29, 2007, in calculating any period of adjustment due to the examination delay in responding to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, a period of adjustment of 11 days pursuant to 37 CFR 1.702(a)(2) is not warranted and will not be entered.

Applicants further disclose that the filing of a Supplemental Information Disclosure Statement (Supplemental IDS) could be a basis for a period of reduction of 17 days. A review of the application history reveals that applicants submitted the Supplemental IDS on June 20, 2008, after filing a reply to the final Office action on May 16, 2008. The record does not support a conclusion that the examiner expressly requested the filing of the Supplemental IDS. Further, a review of the Supplemental IDS, filed June 20, 2008, reveals that applicants

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken[.]

³ 37 CFR 1.702 provides:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

did not include a statement under 37 CFR 1.704(d).⁴ Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application. The period of adjustment of the term of the patent should be reduced pursuant to 37 CFR 1.704(c)(8)⁵ by 35 days (not 17 days), counting the number of days beginning on the day after the date the initial reply in the form of an amendment was filed, May 17, 2008, and ending on the date that the Supplemental IDS was filed, June 20, 2008.

In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is **532 days**.

As this letter was submitted to advise the Office of an error in applicants' favor, the Office will not assess the \$200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the

⁴ 37 CFR 1.704(d) provides:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

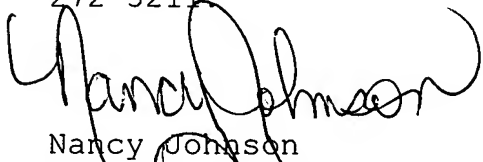
⁵ 37 CFR 1.704(c) provides that the following circumstance constitutes a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Christina Tartera Donnell at (571) 272-3211

A handwritten signature in black ink, appearing to read "Nancy Johnson", written over the typed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM screen

PTA Calculations for Application: 10/765048

Application Filing Date:	01/28/2004	PTO Delay (PTO):	567
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	0
Post-Issue Petitions:	0	Total PTA (days):	532
PTO Delay Adjustment:	-35		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
75	03/23/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		35	
60	07/01/2008	MAIL NOTICE OF ALLOWANCE			
59	06/27/2008	ISSUE REVISION COMPLETED			
58	06/27/2008	DOCUMENT VERIFICATION			
57	06/27/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
56	06/27/2008	EXAMINER'S AMENDMENT COMMUNICATION			
55	06/27/2008	NOTICE OF ALLOWABILITY			
51	06/20/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
50	06/20/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
49	06/03/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
48	06/03/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
47	05/28/2008	DATE FORWARDED TO EXAMINER			
46	05/16/2008	AMENDMENT AFTER FINAL REJECTION			
45	03/17/2008	MAIL FINAL REJECTION (PTOL - 326)			
44	03/11/2008	FINAL REJECTION			
43	01/02/2008	DATE FORWARDED TO EXAMINER			
42	12/17/2007	RESPONSE AFTER NON-FINAL ACTION			
41	09/17/2007	MAIL NON-FINAL REJECTION			
40	09/13/2007	NON-FINAL REJECTION			
38	06/27/2007	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
37	07/10/2007	DATE FORWARDED TO EXAMINER			
36	06/27/2007	RESPONSE AFTER NON-FINAL ACTION			

35	03/27/2007	MAIL NON-FINAL REJECTION			
34	03/19/2007	NON-FINAL REJECTION			
33	03/19/2007	MAIL NOTICE OF WITHDRAWN ACTION			
32	03/19/2007	LETTER WITHDRAWING / VACATING OFFICE ACTION			
31	01/29/2007	MAIL NON-FINAL REJECTION			
30	01/22/2007	NON-FINAL REJECTION			
29	08/19/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
28	07/20/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
27	12/05/2006	DATE FORWARDED TO EXAMINER			
26	11/16/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
25	10/16/2006	MAIL RESTRICTION REQUIREMENT	567		-1
24	01/20/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
23	04/08/2005	CORRESPONDENCE ADDRESS CHANGE			
22	09/09/2004	CASE DOCKETED TO EXAMINER IN GAU			
21	09/08/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
20	07/20/2004	REFERENCE CAPTURE ON IDS			
19.7	08/19/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
19	08/19/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	07/20/2004	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
17.7	07/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	07/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	01/28/2004	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
15	01/28/2004	PRELIMINARY AMENDMENT			
14	01/28/2004	NEW OR ADDITIONAL DRAWING FILED			
12	08/07/2004	APPLICATION RETURN FROM OIPE			
11	08/07/2004	APPLICATION RETURN TO OIPE			
10	08/07/2004	APPLICATION DISPATCHED FROM OIPE			
9	08/09/2004	APPLICATION IS NOW COMPLETE			
8	07/20/2004	ADDITIONAL APPLICATION FILING FEES			
		A STATEMENT BY ONE OR MORE INVENTORS			

7	07/20/2004	SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	06/14/2004	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
5	03/23/2004	CLEARED BY L&R (LARS)			
4	03/11/2004	REFERRED TO LEVEL 2 (LARS) BY OIPE CSR			
3	03/11/2004	CASE CLASSIFIED BY OIPE			
2	03/04/2004	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/28/2004	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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